

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 09/542,866

**REMARKS**

Claims 1-21 and 24-29 are all the claims pending in the application. Claims 1-20 are withdrawn from consideration as being drawn to a non-elected invention. Claims 21 and 24-29 presently stand rejected.

Claims 21, 24-26, 28 and 29 are rejected under 35 U.S.C. § 102(b) as being anticipated by Oguchi (USP 5,646,392).

Claim 27 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Oguchi in view of Aruga et al. (USP 6,574,058).

For the reasons set forth below, Applicant respectfully traverses the rejections and requests favorable disposition of the application.

***Argument***

Initially, Applicant notes that 35 U.S.C. § 103(c) of the U.S. Patent Statute provides that

“subject matter developed by another person which qualifies as prior art only under one or more subsections (e), (f) and (g) of §102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

This provision, which became effective November 29, 1999 for all applications filed after that date, precludes a commonly assigned patent from being prior art under §102(e)/103. On the basis of this section, the Aruga et al. reference should be excluded from use in formulating a rejection against the present application, which was originally filed on April 4, 2000 (CPA filed May 16, 2002), since both the present application and the Aruga et al. reference were commonly owned by the same company, Sankyo Seiki, at the time the invention was made.

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 09/542,866

In particular, an Assignment from the present inventor to Sankyo Seiki, has been recorded in the present application at Reel 010726, Frame 0253 on April 4, 2000. The subject matter of Aruga et al. is assigned on its face to Sankyo Seiki Mfg. Co., Ltd. Applicant submits that the respective subject matters of the present application and Aruga et al. were both owned by Sankyo Seiki at the time the present invention was made. Thus, without further comment, any rejection relying on Aruga et al. is obviated. Specifically, the rejection of claim 27 under 35 U.S.C. §103 should be withdrawn.

Independent claim 21 has been amended to require that “the respective movements of said turning members, said slide member and said shutter plate are all in a substantially single plane.” As clearly disclosed, for example in FIGS. 28 and 30, the movement of the slide member (505), turning members (506) and shutter member (502) are all in substantially the same plane, so as to achieve miniaturization and a thin overall structure. Independent claims 26 and 28 have been similarly amended to recite “wherein said shutter plate and said card entrance are in a substantially single plane.”

Oguchi, in comparison, as shown for example in FIG. 9, discloses the alleged shutter mechanisms 9 and 10, slide members 55 and 56 and turning members 51 and 52, moving in a plurality of planes orthogonal to each other. Oguchi’s structure, therefore, does not achieve miniaturization and a thin structure as compared to the structure claimed.

For at least this reason, the claims of the present application are patentable over Oguchi, either alone or in combination with Aruga, and the rejections should be withdrawn.

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 09/542,866

***Conclusion***

In view of the foregoing remarks, the application is believed to be in form for immediate allowance with claims 21 and 24-29, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Kevin M. Barner  
Registration No. 46,075

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE  
**23373**  
CUSTOMER NUMBER

Date: July 6, 2004

Attorney Docket No.: Q58719